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10/798,864	03/11/2004	Evan Pennell	00216-661001 / Case 8131	6604
26161	7590	10/04/2007	EXAMINER	
FISH & RICHARDSON PC			CHOI, STEPHEN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/798,864

Applicant(s)

PENNELL ET AL.

Examiner

Stephen Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007 & 01 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-36 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,6,14-23,25,26 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,8,12,13,24,27-33,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown, Jr. (US 2004/0055156).

Brown discloses all the recited elements of the invention including a housing having a primary guard (e.g. 26), a primary cap (e.g. 29), and one or more primary shaving blades (e.g. 7-9), a blade carrier (e.g., at 4) defining a rear wall having a rear exterior surface extending downward to a terminating surface and extending along substantially the entire length of a trimming blade (e.g., see Fig. 2, 36) and defining a trimming cap (e.g., 34).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3, 5, 12-13, 24, 27-29, 32-33, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc (US 6,276,061).

Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface extending along substantially the entire length of the trimming blade and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the

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intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24, the modified device of Rozenkranc teaches alignment surfaces (e.g., surfaces on an unlabeled blade holder at 4). Regarding claims 27-28, the modified device of Rozenkranc teaches a shaving aid strip (e.g., 5). Regarding claims 32-33, e.g., Figure 1 of Rozenkranc.

5. Claims 1, 3, 5, 12-13, 24, 27-30, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr. (US 2004/0055156).

Brown discloses the invention substantially as claimed including a housing having a primary guard (e.g. 26), a primary cap (e.g. 29), and one or more primary shaving blades (e.g. 7-9), a blade carrier (e.g., at 4) defining a rear wall having a rear exterior surface extending downward to a terminating surface and extending along substantially the entire length of a trimming blade (e.g., see Fig. 2, 36) and defining a trimming cap (e.g., 34). Brown fails to disclose the blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide the blade carrier made of sheet metal because applicant has not disclosed the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Brown's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 5,

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the modified device of Brown teaches a trimming guard (e.g., 33). Regarding claims 27-28, the modified device of Brown teaches a strip (e.g., paragraph 24). Regarding claim 30, e.g., see paragraph 20 of Brown.

6. Claims 1, 3, 5, 7-8, 12-13, 24, 27-33, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Applicant's Admitted Prior Art (hereafter AAPA).

In alternative, if it is argued that Rozenkranc does not teach the rear exterior surface extending along substantially the entire length of the trimming blade, Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement since both

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arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the rear exterior surface extending along substantially the entire length of the trimming blade on the device of Rozenkranc since providing a rear exterior surface extending along substantially the entire length of a blade or blades as old and well known in the art for the purpose of providing a blade supporting body as admitted by the applicant. *Aprille, Carson, and Metcalf* show examples of a commercially available multi-blade shaving apparatus with a rear exterior surface extending along substantially the entire length of blades. It is noted that the common knowledge or well-known in the art statement of the previous office action has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03. Regarding claims 7-8, the modified device of Rozenkranc discloses the invention substantially as claimed except for one or more skin protection structures between the trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Rozenkranc in order to protect the user's skin. Regarding claims 30-31, the modified device of Rozenkranc fails to disclose four or more primary shaving blades or five or more primary shaving blades. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ four or five or more primary blades as taught by AAPA on the modified device of Rozenkranc in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or that the traverse was inadequate. See MPEP § 2144.03.

7. Claims 7-8 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of AAPA.

Regarding claims 7-8, the modified device of Brown discloses the invention substantially as claimed except for one or more skin protection structures between the trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Brown in order to protect the user's skin. Regarding claim 31, the modified device of Brown fails to disclose five or more primary shaving blades. However, it would have been obvious to one having ordinary

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skill in the art at the time the invention was made to employ five or more primary blades as taught by AAPA on the modified device of Brown in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03.

Response to Arguments

8. Applicant's arguments filed July 23, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments that 1) Rozenkranc does not disclose a blade carrier as claimed mounted on the housing, 2) Rozenkranc does not teach a trimming assembly that is attached to the back of the housing, and 3) Brown does not teach an assembly mounted on the housing.

The examiner respectfully disagrees. As set forth above, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Hence, it would have been obvious to one of ordinary skill in the art to provide a discrete assembly that is mountable on the housing of Rozenkranc.

Furthermore, Brown teaches a trimming assembly that is integrally attached to the housing. Moreover, as stated previously, although Rozenkranc fails to show cross-hatching on Figure 1, Rozenkranc teaches a plastic body, which the trimming blade is mounted therewithin in the same slot as are the shaving blades, is substantially the same as those being used in the commercially available multi-blade shaving apparatus

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except for the body being slightly lengthened to accommodate the trimming blade.

Thus, it is the examiner's position that the specification along with Figures in the reference to Rozenkranc teaches the rear exterior surface extending along substantially the entire length of the trimming blade. The rear wall is located where the rear exterior surface is shown on the attached figure of the office action mailed February 6, 2006.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Choi/
Primary Examiner, AU 3724
28 September 2007